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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,650	09/28/1999	PETER M. MANSOUR	40062.7US01	3018

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Merchant & Gould P.C.
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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2177

11

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/407,650

Applicant(s)

MANSOUR ET AL.

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Reconsideration

1. This Office Action is in response to the applicants' communication received on December 24, 2003, paper no. 10.
2. Claims 1-34 are presented for examination.
3. Applicant's arguments received on December 24, 2003 have been fully considered but they are not deemed to be persuasive.

DECLARATION

4. The applicants have submitted declarations under 37 C.F.R. 1.131 in which they maintain that they invented the claimed subject matter before the filing date of the Noren patent application.

However, the declarations filed on December 24, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Noren reference.

The applicants' declarations provide statements regarding the serial number and filing date of their present patent application. Also, statements are provided where the applicants acknowledge that they have invented subject matter described and claimed in their present application (09/407,650) before the filing date of the Noren patent application filed on July 29, 1999, also cited in the Examiner's 103 rejection.

The applicants' declarations are ineffective because no evidence has been submitted. The declarations are insufficient because no evidence was submitted in an

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effort to establish a conception of the invention prior to the effective date of the Noren reference.

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the facts. Evidence in the form of exhibits may accompany the declaration. Each exhibit relied upon should be specifically referred to in the declaration, in terms of what it is relied upon to show. Facts might be supported by submitting as evidence one or more of the following: (a) attached sketches; (b) attached blueprints; (c) attached photographs; (d) attached reproductions of notebook entries; (e) an accompanying model, etc. Applicants' are advised to review the MPEP 715.07.

Again the declarations and exhibits must clearly explain which facts or data applicants are relying on to show completion of their invention prior to the particular date. Particularly, declarations and exhibits must clearly explain which facts or data applicants are relying on to show completion of their invention with regards to the specific claim limitations taught by the Noren patent application as cited in the 103 rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-10, 12-18, 20-25, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noren et al. (Pat. No. (5,446,091 B I filed 7/29/1999, hereinafter Noren); Montville et al. (Pat. No. 6,356,937 B I filed 7/6/1999, hereinafter Montville); and Furusawa et al. (Pat. No. 4,663,736 filed 12/11 /1984).

7. Regarding Claims 1, 12, 20, 21, and 27, Noren teaches a method and apparatus for undeleting files in a computer system.

The method and associated system for undeleting files in a computer system as taught or suggested by Noren includes:

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marking folders to be retained with a flag (col. 7, lines 29-39, '...a deleted file is flagged with an identifier and hidden from the user. In this example, rather than being deleted, the file still exists but is hidden from the user. The identifier may include any type of flag that is recognizable by the server 14, and in one embodiment, the identifier includes the date and time the file was deleted. Furthermore, the identifier may include the location of the file (i.e., the directory path.) As will be described below, when a file is undeleted, the undeleted file is returned to the same directory path, and if the path no longer exists, it is recreated by the file undelete software 62. '); and marking folders to be deleted with a cleanup flag (col. 7, lines 60-67, col. 8, lines 144, '...older deleted files may be periodically purged from the primary and expansion storage devices 68, 72 ... A purge process may run periodically checking the identifier for each deleted file to determine whether that deleted file exceeds the threshold purge flag.').

The applicants' claim 1 is broadly claimed wherein, folders are marked with a first flag to retain information in the folders and folders are marked again with a second flag to delete information in the folders. Again, the applicants' claim 12 is more specifically claimed wherein, folders are marked with an offline flag to retain information in the folders and folders are marked again with a cleanup flag to delete information in the folders. The examiner believes that the Noren reference teaches multiple flag conditions that must be met as specified by the applicants. First, the conditioning for retaining the information as specified by a first flag and an offline flag is determined by the same conditioning factors. Wherein, the terminology for a first flag is broadly claimed, whereas the terminology for an offline flag is more specifically claimed. However, both of these

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flags are to achieve the same objective, in terms of retaining information within a folder. The conditioning for the first flag and the offline flag means is established by flagging at least one deleted file with an identifier, the identifier may include any type of flag that is recognizable by the server. The flagged delete file is hidden in the computer system. A list of deleted files that have been flagged with the identifier is generated. The list of deleted files is comprised of a directory path hierarchy for each deleted file. A file is selected from the list of deleted files and is then undeleted, the undeleted file is returned to the same directory path, and if the path no longer exists, it is recreated by the file undelete software 62. If the flagged delete file is already hidden in the computer system and is later selected or identified by the type of flag identifier to be undeleted, then the first condition has been met in terms of retaining the information in the file or folder (Abstract, lines 1-7, col. 7, lines 29-39). Again, the second condition that has to be met is to delete information within the folder. The second condition is first established by a second flag and a cleanup flag. The terminology for a second flag is broadly claimed, whereas the terminology for the cleanup flag is specifically claimed. However, both the second flag and the cleanup flag must achieve the same objective by deleting information within the file. Noren teaches deleting information from the file. Noren uses a purge flag to meet the conditions for the second flag and a cleanup flag. Microsoft Press Computer Dictionary defines purging as a means 'to clean up'. Therefore, Noren establishes a purge flag for a file, the file comprises an identifier, the identifier is assigned to a delete file and may include the date and time the file was deleted (col. T, lines 59-67, col. 8, lines 1-13).

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However, Noren does not expressly teach the claimed off-line means.

Montville teaches interoperable full-featured web-based and client-side e-mail system.

The method and associated system for interoperable full-featured web-based and client side e-mail system as taught or suggested by Montville includes:

off-line means (Abstract, lines 6-8, 'In either form and at either level of service, subscribers can work off-line on their own computers with proprietary software...').

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Noren with Montville's off-line means because Montville's off-line means enables a user having a client computer, i.e. 'client-side', to compose, send, and receive e-mails, client-programs are often required, further enabling clients or users to work off-line and then dial in to a central server just to upload and download their messages (col. 1, lines 15-35).

However, Montville does not expressly teach folders containing messages to be retained and deleted.

Furusawa teaches a file deletion system in a file unit.

The method and associated system for a file deletion system in a file unit as taught or suggested by Furusawa includes:

folders containing messages to be retained and deleted (col. 3, lines 27-43, 'Each line of the display except the first line has the set/rest code (* or space). When that code is *, then, the message following the symbol 4: on the line is not deleted, and

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when that code is space, then, the message following the code is to be deleted by the next operation.').

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Montville with Furusawa's method to retain and delete messages within folders because Furusawa's method enables deletion of a particular message in a file unit is accomplished for those messages with deletion set code in a file directory displayed on a screen, operation of the deletion of message includes depression of 'deletion key' for indicating a file directory on a screen and designating messages to be deleted by depression of a deletion set/reset key to change a deletion set/reset code to a set code.

8. Regarding Claim 2, the limitations of this claim has been noted in the rejection above.

It is therefore rejected as set forth above.

9. Regarding Claims 3, 13, 22, and 28, Furusawa teaches marking folders having messages to be deleted (Abstract, lines 1-14, 'Deletion of a particular message in a file unit is accomplished for those messages with deletion set code in a file directory displayed on a screen. Operation of the deletion of message includes (a) depression of 'deletion key' for indicating a file directory on a screen (b) designating messages to be deleted by depression of a deletion set/reset key to change a deletion set/reset code to a set code.'). placing messages into folders (Abstract, lines 1-14, 'Deletion of a particular message in a file unit is accomplished for those messages with deletion set code in a file directory displayed on a screen. Operation of the deletion of message

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includes (a) depression of 'deletion key' for indicating a file directory on a screen (b) designating messages to be deleted by depression of a deletion set/reset key to change a deletion set/reset code to a set code.'). the messages being contained within individual folders (Abstract, lines 1-14, 'Deletion of a particular message in a file unit is accomplished for those messages with deletion set code in a file directory displayed on a screen. Operation of the deletion of message includes (a) depression of 'deletion key' for indicating a file directory on a screen (b) designating messages to -be deleted by depression of a deletion set/reset key to change a deletion set/reset code to a set code.').

10. Regarding Claims 4, Noren teaches marking folders to be deleted with a second flag (col. 7, lines 60-67, col. 8, lines 1-14, '...older deleted files may be periodically purged from the primary and expansion storage devices 68, 72 ... A purge process may run periodically checking the identifier for each deleted file to determine whether that deleted file exceeds the threshold purge flag.').

Again, the second condition that has to be met is to delete' information within the folder. The second condition is first established by a second flag. The terminology for a second flag is broadly claimed, whereas the terminology for the cleanup flag is specifically claimed. However, both the second flag and the cleanup flag must achieve the same objective by deleting information within the file. Noren teaches deleting information from the file. Noren uses a purge flag to meet the conditions for the second flag and a cleanup flag. Microsoft Press Computer Dictionary defines purging as a means 'to clean up'. Therefore, Noren establishes a purge flag for a file, the file

comprises an identifier, the identifier is assigned to a delete file and may include the date and time the file was deleted (col. 7, lines 59-67, col. 8, lines 1-13).

Furusawa teaches placing messages into folders (col. 2, lines 13-17, '...a file generator means for generating a file directory, wherein said file directory consists of a list of files containing at least said particular message; a display means for indicating said list of said file directory containing said particular message...').

11. Regarding Claims 5, 15, and 30, Montville teaches downloading messages (col., 26, lines 56-67, 'Whether User C uses his regular Computer C or another Computer Z, neither one having EMC loaded, he/she may download the message and have it...'), including a server (figure 1, element SERVER 1) and client device (figure 1, element Computer X, Y, Z, etc.).

12. Regarding Claims 6 and 16, Montville teaches connecting the client device to the server (col. 26, lines 26-35, 'If User A is away from home or office and cannot use his Computer A, he/she still can send and receive e-mail with all the information and options of his home Computer A. He/she need only log onto, Sever I from any computer with...').

13. Regarding Claims 7, 23, and 31, the limitations of these claims have been noted in the rejection above. They are therefore rejected as set forth above.

14. Regarding Claims 8, 17, 25, and 32, the limitations of this claim has been noted in the rejection above. In addition, Montville teaches disconnecting the client device (a client computer, i.e. 'client-side', to compose, send, and receive e-mails, client-programs

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are often required, further enabling clients or users to work off-line and then dial in to a central server just to upload and download their messages (col. 1, lines 15-35).

15. Regarding Claims 9, 18, and 33, Furusawa teaches after deleting messages, removing the folders to unmark the folders (col. 3, lines 27-43, 'Each line of the display except the first line has the set/rest code (* or space): When that code is *, then, the message following the symbol * on the line is not deleted, and when that code is space, then, the message following the code is to be deleted by the next operation.').

16. Regarding Claims 10 and 24, Furusawa teaches marking folders having messages to be deleted (col. 3, lines 27-43, 'Each line of the display except the first line has the set/rest code (* or space). When that code is *, then, the message following the symbol * on the line is not deleted, and when that code is space, then, the message following the code is to be deleted by the next operation.').

Montville teaches connecting the client device to a server (col. 26, lines 26-35, 'If User A is away from home or office and cannot use his Computer A, he/she still can send and receive e-mail with all the information and options of his home Computer A. He/she need only log onto Server I from any computer with...').

17. Regarding Claims 14 and 29, Noren teaches marking folders having messages to be deleted with a cleanup flag (col. 7, lines 60-67, col. 8, lines 1-14, '...older deleted files may be periodically purged from the primary and expansion storage devices 68, 72 ... A purge process may run periodically checking the identifier for each deleted file to determine whether that deleted file exceeds the threshold purge flag.').

Again, the second condition that has to be met is to delete information within the

folder. The second condition is first established by a second flag. The terminology for a second flag is broadly claimed, whereas the terminology for the cleanup flag is specifically claimed. However, both the second flag and the cleanup flag must achieve the same objective by deleting information within the file. Noren teaches deleting information from the file. Noren uses a purge flag to meet the conditions for the second flag and a cleanup flag. Microsoft Press Computer Dictionary defines purging as a means 'to clean up'. Therefore, Noren establishes a purge flag for a file, the file comprises an identifier, the identifier is assigned to a delete file and may include the date and time the file was deleted (col. 7, lines 59-67, col. 8, lines 1-13).

Furusawa teaches placing messages into folders (col. 2, lines 13-17, '...a file generator means for generating a file directory, wherein said file directory consists of a list of files containing at least said particular message; a display means for indicating said list of said file directory containing said particular message...').

18. Claims 11, 19, 26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noren et al. (Pat. No. 6,446,091 131 filed 7/29/1999, hereinafter Noren); Montville et al. (Pat. No. 6,356,937 B1 filed 7/6/1999, hereinafter Montville); and Furusawa et al. (Pat. No. 4,663,736 filed 12/11/1984) as applied to claims 1, 12, 20, and 27 above, and further in view of Birrell et al. (Pat. No. 6,092, 101 filed 6/16/1997, hereinafter Birrell).

19. Regarding Claims 11, 19, 26, and 34, the limitations of these claims have been noted in the rejection above. In addition, Noren, Montville, and Furusawa do not expressly teach parsing folders.

Birrell teaches a method for filtering mail messages for a plurality of client computers connected to a mail service system.

The method and associated system for filtering mail messages for a plurality of client computers connected to a mail service system as taught or suggested by Birrell includes:

parsing folders (Abstract, lines 1-114, 'Mail messages are stored in message files of the mail service system. Each mail message is parsed and indexed to generate a full-text index of the mail service system.').

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the methods of Noren, Montville, and Furusawa with Birrell's method to parse folders because Birrell's method enables filtering mail messages in a distributed computer system, the mail messages are stored in message files, where each message is parsed and indexed to generate a full-text index of the mail service system (Abstract, lines 1-14).

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

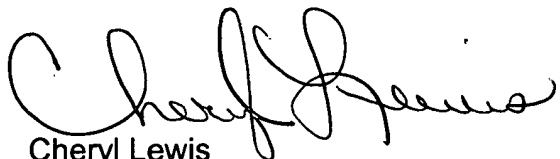
NAME OF CONTACT

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (703) 305-8750. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

(703) 746-5651 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Cheryl Lewis
Patent Examiner
March 5, 2004



JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100